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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/551,175	09/29/2005	Mitsuhiro Watanabe	00862.023664.	4248
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EXAMINER				
MURRAY, DANIEL C				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/551,175

Applicant(s)

WATANABE ET AL.

Examiner

DANIEL MURRAY

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29SEP2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SI/02)
- Paper No(s)/Mail Date See Continuation Sheet
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

29NOV2005, 21NOV2006, 23MAY2007, 19SEP2007, 25JAN2008, and 06FEB2008

DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 10/551175, filed on 29SEP2005.

Information Disclosure Statement

3. The information disclosure statements submitted on 29NOV2005, 21NOV2006, 23MAY2007, 19SEP2007, 25JAN2008, and 06FEB2008 have been considered by the Examiner and made of record in the application.

Specification

4. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.
5. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. **Claim 1-4, 8, 10-14, and 17-18** are rejected under 35 U.S.C. 102(b) as being anticipated by **Ozawa et al. (US Patent # 6,115,137)**.

a) Consider **claim 1 and 2**, Ozawa et al. clearly show and disclose, a wireless communication system and device which comprises a first wireless communication device that stores information to be transmitted, and a second wireless communication device that receives the information and applies a predetermined process to the information (figure 1, figure 2, figure 3, abstract, column 4 lines 45-67, column 5 lines 1-10 lines 31-51), wherein each of said first and second wireless communication devices comprises: determination means for determining a user's instruction for establishing a wireless communication channel (figure 2, figure 3, figure 5, figure 6, column 6 lines 19-32 lines 49-65); and communication establishment means for, when said determination means determines that the user's instruction is detected, executing a process for establishing a wireless communication within a predetermined time period (figure 2, figure 3, figure 5, figure 6, abstract, column 6 lines 19-32 lines 49-65), and when a communication channel is established by said communication establishment means of said first and second wireless communication devices, said first wireless communication device transmits information to said second wireless communication device, which applies the predetermined process to the received information (figure 2, figure 3, figure 5, figure 6, abstract, column 6 lines 19-32 lines 66-67, column 7 lines 1-9 lines 39-46).

b) Consider **claim 3**, and **as applied to claim 2 above**, Ozawa et al. clearly show and disclose, the device according to claim 2, further comprising: transmission means for, when said determination means determines that the wireless communication channel establishment instruction is detected, transmitting a request signal that requests to establish the wireless communication channel (figure 5, column 6 lines 19-65); and detection means for detecting a response to the request

signal transmitted by said transmission means, and detecting a wireless communication channel establishment request signal from another wireless communication device, and in that said detection means executes a process within the predetermined time period (figure 6, column 7 lines 10-14 lines 15-38).

c) Consider **claim 4**, and **as applied to claim 2 above**, Ozawa et al. clearly show and disclose, the device according to claim 2, wherein said wireless communication device comprises an image sensing device, and the other wireless communication device comprises a device for printing a sensed image or a storage device for storing the sensed image (figure 3, figure 2, figure 3, abstract, column 4 lines 45-54).

d) Consider **claim 8**, and **as applied to claim 2 above**, Ozawa et al. clearly show and disclose, the device according to claim 2, further comprising: selection means for selecting information to be transmitted, and in that when said selection means has already selected the information to be transmitted upon establishing the wireless communication channel by said communication establishment means, said communication means executes a transmission process of the selected information (column 11 lines 26-46).

e) Consider **claim 10**, and **as applied to claim 2 above**, Ozawa et al. clearly show and disclose, the device according to claim 2, wherein said wireless communication device can make communications in a plurality of communication modes, and when said determination means determines that the wireless communication channel establishment instruction is detected, said communication establishment means executes a process for establishing the wireless communication channel in a first communication mode (column 6 lines 49-65, column 7 lines 39-49).

f) Consider **claim 11**, and **as applied to claim 10 above**, Ozawa et al. clearly show and disclose, the device according to claim 10, further comprising: switching means for, when a second

communication mode is set before the operator inputs the instruction, switching the second communication mode to the first communication mode (column 6 lines 49-65, column 7 lines 39-49), and in that said switching means switches the first communication mode to the second communication mode upon completion of the communication with the other wireless communication device (column 6 lines 49-65, column 7 lines 39-49).

g) Consider **claim 12**, Ozawa et al. clearly show and disclose, a wireless communication device comprising: determination means for determining an operator's instruction for establishing a wireless communication channel (figure 2, figure 3, figure 5, figure 6, column 6 lines 19-32 lines 49-65); detection means for executing a detection process of a wireless communication channel establishment request signal transmitted from another wireless communication device for a predetermined time period in response to determination of the instruction by said determination means (figure 5, figure 6, column 6 lines 19-65, column 7 lines 10-14 lines 15-38); and communication establishment means for executing a process for establishing the wireless communication channel in response to detection by said detection means (figure 2, figure 3, figure 5, figure 6, abstract, column 6 lines 19-32 lines 66-67, column 7 lines 1-9 lines 39-46).

h) Consider **claim 13**, and **as applied to claim 12 above**, Ozawa et al. clearly show and disclose, the device according to claim 12, further comprising transmission means for, when said detection means detects the establishment request signal, transmitting a response signal to the establishment request signal (figure 2, figure 3, figure 5, figure 6, abstract, column 6 lines 19-32 lines 66-67, column 7 lines 1-9 lines 39-46).

i) Consider **claim 14**, and **as applied to claim 12 above**, Ozawa et al. clearly show and disclose, the device according to claim 12, further comprising transmission means for controlling said detection means to start the detection process in response to determination of the instruction

by said determination means, and transmitting a request signal that requests to establish the wireless communication channel (figure 2, figure 3, figure 5, figure 6, abstract, column 6 lines 19-32 lines 66-67, column 7 lines 1-9 lines 39-46).

j) Consider **claim 17**, Ozawa et al. clearly show and disclose, a method of controlling a wireless communication device, comprising: a determination step of determining an operator's instruction for establishing a wireless communication channel (figure 2, figure 3, figure 5, figure 6, column 6 lines 19-32 lines 49-65); a communication establishment step of executing a process for establishing the wireless communication channel with another wireless communication device at which an instruction for establishing the wireless communication channel has been made within a predetermined time period since it is determined in the determination step that the instruction is detected (figure 2, figure 3, figure 5, figure 6, abstract, column 6 lines 19-32 lines 66-67, column 7 lines 1-9 lines 39-46); and a communication step of communicating, when the wireless communication channel is established in the communication establishment step, with the other wireless communication device (figure 2, figure 3, figure 5, figure 6, abstract, column 6 lines 19-32 lines 66-67, column 7 lines 1-9 lines 39-46).

k) Consider **claim 18**, Ozawa et al. clearly show and disclose, a method of controlling a wireless communication device, comprising: a determination step of determining an operator's instruction for establishing a wireless communication channel (figure 2, figure 3, figure 5, figure 6, column 6 lines 19-32 lines 49-65); a detection step of executing a detection process of a wireless communication channel establishment request signal transmitted from another wireless communication device for a predetermined time period since it is determined in the determination step that the instruction is detected (figure 5, figure 6, column 6 lines 19-65, column 7 lines 10-14 lines 15-38); and a communication establishment step of executing, when the establishment request

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is detected in the detection step within the predetermined time period, a process for establishing the wireless communication channel with the other wireless communication device (figure 2, figure 3, figure 5, figure 6, abstract, column 6 lines 19-32 lines 66-67, column 7 lines 1-9 lines 39-46).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. **Claim 5** is rejected under 35 U.S.C. 103(a) as being unpatentable over **Ozawa et al. (US Patent # 6,115,137)** in view of **Chou et al. (US Patent # 6,065,123)**.

a) Consider **claim 5**, and as **applied to claim 2 above**, Ozawa et al. clearly show and disclose, the device according to claim 2. However, Ozawa et al. does not specifically disclose a power supply control means for, when it is determined that the wireless communication channel establishment instruction is detected, turning on a power supply of a communication function unit required to make a wireless communication, and for, when the communication establishment process by said communication establishment means has failed, turning off the power supply of the communication function unit.

Chou et al. show and disclose a computer system with unattended on-demand availability includes power-saving features which place the system into a Standby mode whenever the system is idle or is not being use, wherein a power supply control means for, when it is determined that the wireless communication channel establishment instruction is detected, turning on a power supply of a communication function unit required to make a wireless communication, and for, when the communication establishment process by said communication establishment means has failed, turning off the power supply of the communication function unit (figure 3, abstract, column 2 lines 58-67, column 11 lines 60-65, column 12 lines 15-39).

Therefore, it would have been obvious to one of ordinary skill in the art that the time the invention was made to incorporate the teachings of Chou et al. into the system of Ozawa et al. for the purpose of conserving power.

12. **Claim 6** is rejected under 35 U.S.C. 103(a) as being unpatentable over **Ozawa et al. (US Patent # 6,115,137)**.

a) Consider **claim 6**, and **as applied to claim 2 above**, Ozawa et al. clearly show and disclose, the device according to claim 2. However, Ozawa et al. does not specifically disclose that when no candidate device or at least two candidate devices are detected upon establishing the wireless communication channel, the communication establishment process is aborted.

Nonetheless, it would have been obvious to one of ordinary skill in the art at the time the invention was made to abort the communication establishment process if no candidate device was detected upon establishing a wireless connection channel because there would be no need to establish a connection if there was not candidate device detected so it would be obvious to abort the communication establishment process.

b) Consider **claim 15**, and **as applied to claim 12 above**, Ozawa et al. clearly show and disclose, the device according to claim 12, wherein said wireless communication device can also make a wired communication (figure 26, column 17 lines 3-16). However, Ozawa et al. does not specifically disclose the operator's instruction is ignored during a process of information received via the wired communication.

Nonetheless, it would have been obvious to one of ordinary skill in the art at the time the invention was made to ignore the operator's instructions to establish a wireless communication channel is one has already been established via wired channel.

c) Consider **claim 16**, and **as applied to claim 12 above**, Ozawa et al. clearly show and disclose, the device according to claim 12, wherein said wireless communication device can also make a wired communication (figure 26, column 17 lines 3-16). However, Ozawa et al. does not specifically disclose when said determination means determines that the instruction is detected

during a process of information received via the wired communication, the process of information received via the wired communication is interrupted, and a communication is made via the wireless communication channel established by said communication establishment means.

Nonetheless, it would have been obvious to one of ordinary skill in the art at the time the invention was made to interrupt communication via one type of communication channel (i.e. wired) if an instruction to establish another type of communication channel (i.e. wireless) is given. In other words simply overriding one process based on the detection of a command to start another process would have been obvious.

13. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ozawa et al. (US Patent # 6,115,137) in view of Simpson et al. (US Patent Publication # US 2003/0014446 A1).

a) Consider **claim 7**, and **as applied to claim 2 above**, Ozawa et al. clearly show and disclose, the device according to claim 2, wherein upon establishing the wireless communication channel, when only one candidate device is detected (figure 2, figure 3, figure 5, figure 6, abstract, column 6 lines 19-32 lines 66-67, column 7 lines 1-9 lines 39-46). However, Ozawa et al. does not specifically disclose when the communication channel is established, when a plurality of candidate devices are detected, a list is displayed to prompt an operator to select one of the candidate devices, and the communication channel is established with the selected candidate.

Simpson et al. show and disclose printing and distributed environments, and more particularly pre-defined print option configurations for printing in a distributed environment, wherein when a plurality of candidate devices are detected, a list is displayed to prompt an operator to select one of the candidate devices, and the communication channel is established with the selected candidate (figure 4, figure 6, paragraph [0039], [0044]).

Therefore, it would have been obvious to one of ordinary skill in the art that the time the invention was made to incorporate the teachings of Simpson et al. into the system of Ozawa et al. for the purpose of displaying a list of printers available on a network.

14. **Claim 9** is rejected under 35 U.S.C. 103(a) as being unpatentable over **Ozawa et al. (US Patent # 6,115,137)** in view of **Ohta (US Patent Publication # US 2001/0029531 A1)**.

a) Consider **claim 9**, and as **applied to claim 2 above**, Ozawa et al. clearly show and disclose, the device according to claim 2. However, Ozawa et al. does not specifically disclose a search means for, when said determination means determines that the wireless communication channel establishment instruction is detected, searching for a communication partner in accordance with a plurality of communication parameters, and in that said communication establishment means establishes the wireless communication channel with the communication partner found by said search means.

Ohta shows and discloses printing at a convenient location, and more particularly related to a system for and method of printing information at a conveniently located printer station that is selected in a predetermined area, wherein a search means for, when said determination means determines that the wireless communication channel establishment instruction is detected, searching for a communication partner in accordance with a plurality of communication parameters, and in that said communication establishment means establishes the wireless communication channel with the communication partner found by said search means (figure 4, abstract, paragraph [0040]).

Therefore, it would have been obvious to one of ordinary skill in the art that the time the invention was made to incorporate the teachings of Ohta into the system of Ozawa et al. for the purpose of printing information at a conveniently located printer station.

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Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- | | |
|----------------------|----------------------|
| ➤ 6,163,816 | ➤ 5,937,148 |
| ➤ US2002/0041388 A1 | ➤ US 2002/0097423 A1 |
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| ➤ US 2002/0161740 A1 | ➤ WO 01/93514 A1 |
| ➤ US 2004/0039811 A1 | ➤ WO 2007/007758 A1 |
| ➤ US 7,239,416 B2 | |

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL MURRAY whose telephone number is 571-270-1773. The examiner can normally be reached on Monday - Friday 0800-1700 EST.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn can be reached on (571)-272-1915. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Daniel Murray/
Examiner, Art Unit 2143

/Nathan J. Flynn/
Supervisory Patent Examiner, Art Unit 2154